

Notice of Allowability

Application No.

10/786,610

Applicant(s)

CUI ET AL.

Examiner

Art Unit

Zachary C. Tucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 30 June 2006.
2. ☒ The allowed claim(s) is/are 1,4,5,7,9,12-14,16,18,30,31,34,35 and 38.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 30 JUN 06
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone conversation between the examiner and applicants' counsel, Mr. Matthew E. Mulkeen, on 9 August 2006.

IN THE CLAIMS –

In claim 1, at page 2 of the correspondence filed by applicants on 30 June 2006, line 17, the following deleted material has been re-inserted:

A^1 is $(CR^9R^{10})_n-A^2$

Immediately after the above re-inserted material, the phrase "except that" and the following four lines of text **are to remain deleted**, as indicated in applicants' amendment, filed 30 June 2006.

end of amendment

Response to Amendment

As requested by applicants in the correspondence filed 30 July 2006 (hereinafter "present amendment"), which is in reply to the Office action mailed 30 March 2006 (hereinafter "previous Office action"), claims 1, 12, 30, 34 and 38 have been amended and claims 2, 3, 6, 8, 10, 11, 15, 17, 19-29, 32, 33 and 36-48 have been cancelled.

Election/Restrictions

A Requirement for Restriction, with a further requirement for applicants to elect a single disclosed species for examination purposes, was issued 30 January 2006. By virtue of the present amendment, all claims previously indicated as being withdrawn, either for not being drawn to the elected invention or for not being readable on the elected species, have been cancelled. Therefore, the Requirement for Restriction issued 30 January 2006 is hereby WITHDRAWN.

Obviousness-Type Double Patenting

In the previous Office action, claims 1, 3-5, 7, 9, 12-14, 16, 18, 30, 31, 34, 35 and 38 were provisionally rejected under the doctrine of obviousness-type double patenting (ODP) as being unpatentable over claims 1-5 of copending application serial number 11/213,038.

Cancellation of instant claim 3 has rendered the rejection of that claim moot.

As for the provisional ODP rejection of claims 1, 4, 5, 7, 9, 12-14, 16, 18, 30, 31, 34, 35 and 38, it is the only remaining issue with regard to the instant application's being in condition for allowance (all other objections/rejections having been overcome and withdrawn, as explained in the following). Thus, the ODP rejection is hereby withdrawn pursuant to the practice outlined in MPEP 804(I)(B)(1).

Status of Claim Rejections - 35 USC § 112

In the previous Office action, claims 1, 3-5, 7, 9, 12-14, 16, 18, 30, 31 and 38 were rejected under the *first* paragraph of 35 U.S.C. 112, for lack of a disclosure enabling the production of the claimed solvates of the compounds according to those claims.

Claim 3 has been cancelled, all rejections of that claim are now moot.

In view of the present amendment, the rejection of claims 1, 4, 5, 7, 9, 12-14, 16, 18, 30, 31 and 38 is hereby withdrawn. "Solvate" has been deleted from the claims.

In the previous Office action, claims 1, 3-5, 7, 9, 12-14, 16, 18, 30, 31, 34, 35 and 38 were rejected under the *second* paragraph of 35 U.S.C. 112, for indefiniteness of the terms "heteroaryl" and "heterocyclic," as they are recited in the claims. No specific, exact and concise definition of the terms is set forth in the specification. In view of the present amendment, however, adding language to the claims which clearly sets forth a Markush group from which the terms "heteroaryl" and "heterocyclic" are to be chosen, the rejection of claims 1, 4, 5, 7, 9, 12-14, 16, 18, 30, 31, 34, 35 and 38 is hereby withdrawn.

Status of Claim Rejections - 35 USC § 102

In the previous Office action, claims 1, 3, 4, 12, 13, 30 and 31 were rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/37080 (Amin et al) and US 6,313,137 (Amin et al '137).

In view of the present amendment, which deletes from variable R¹ all possible identities other than C₆₋₁₂ aryl, 5-12 membered heteroaryl, C₃₋₁₂ cycloalkyl and 3-12

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membered heteroalicyclic, the rejections based on Amin et al are hereby withdrawn.

Amin et al only discloses compounds wherein the substituent corresponding to R¹ of the instant claims is methyl.

Claim Rejections - 35 USC § 103

In the previous Office action, claims 7 and 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Amin et al '137.

Because the anticipation rejection based on the Amin et al '137 reference has been overcome by amendment, the rejection under this statute is necessarily also overcome by the same amendment.

Allowable Subject Matter

Claims 1, 4, 5, 7, 9, 12-14, 16, 18, 30, 31, 34, 35 and 38 are allowed.

The following is an examiner's statement of reasons for allowance:

As was stated in the previous Office action, on page 17, the closest prior art with respect to the subject matter of the instant claims is the prior art applied in the rejections set forth therein.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

All Post-Allowance Correspondence concerning this application must be mailed to:

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Or you can fax them to the Office of Patent Publications at 703-872-9306, in order to expedite the handling of such correspondence as amendments under 37 CFR 1.312; information disclosure statements, and formal drawings. Sending Post-Allowance papers to Technology Center 1600 will only cause delays in matching papers with the case.

For information concerning status of correspondence sent after receipt of the Notice of Allowance, please contact the Correspondence Branch at (703) 305-8027. The Notice of Allowance also has an insert containing contact information on other items, including Issue Fees, receipt of formal drawings and the status of the application.

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A handwritten signature in black ink, appearing to be "Z. L. H.", followed by a long horizontal line.